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OBLON, SPIVAK, MCCLELLAND MAIER
& NEUSTADT, L.L.P.
1940 Duke Street
Alexandria, VA 22314

In re Application of:	:	
WALDMANN et al	:	DECISION ON PETITION
Application No.: 09/129,758	:	UNDER 37 CFR 1.137(b) AND
PCT No.: PCT/FR98/00270	:	PAPERS UNDER 37 CFR 1.42
Int. Filing Date: 11 Feb 1998	:	
Priority Date: 11 Feb 1997	:	
Attorney's Docket No.: 328255US0PCT	:	
For: MAMMAL NEURONAL ACI	:	
SENSING CATIONIC CHANNEL, CLONING	:	
AND APPLICATIONS THEREOF	:	

This is in response to the "37 CFR 1.137(b) Petition to Revive" filed 09 April 2010, and the submission filed 07 July 2010, which has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 11 February 1998, applicants filed international application no. PCT/FR98/00270 designating the United States and having a priority date of 11 February 1997. There is no record of a Demand for international preliminary examination being filed within 19 months from the priority date. Accordingly, the 20-month deadline under former 37 CFR 1.494 to pay the basic national fee to avoid abandonment expired at midnight of 12 October 1998 (11 October 1998 fell on a Sunday).

On 05 August 1998, applicants filed, *inter alia*, a transmittal letter, a non-English copy of PCT application no. PCT/FR98/00270, a declaration (unexecuted), and a communication entitled "Request for the Acceptance of Non-English Application Under 37 CFR 1.52(d)". The submission was accompanied by payment of \$130 for the fee required under §1.52(d) and did not include deposit account authorization to charge any outstanding fees.

On 31 August 1998, a "Notice to File Missing Parts-Filing Date Granted" was mailed to applicants indicating a deficiency in the basic filing fee.

On 01 February 1999, applicants filed a response to the 31 August 1998 Notice including payment of the required fees and an executed declaration. Shortly thereafter, on 02 March 1999, an official Filing Receipt was mailed to applicants identifying the present application as a U.S.

national stage application of PCT/FR98/00270. See "Transmittal of Errors in Filing Receipt" filed by applicants on 25 March 1999.

On 09 April 2010, applicants filed the petition under 37 CFR 1.137(b) considered herein.

On 07 July 2010, applicants filed declarations executed by, *inter alia*, legal representatives of a deceased inventor. The submission has been treated as a request for status under 37 CFR 1.42.

DISCUSSION

I. Petition Under 37 CFR 1.137(b)

As indicated above, the present application was initially identified by the Office as a U.S. national stage application under 35 U.S.C. 371, and this indication has remained throughout the subsequent eleven years of prosecution.¹ However, the application was never formally processed as a national stage application. For example, a "Notification of Acceptance Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903) was never issued. While applicants' initial submission of 05 August 1998 does not include the typical documents associated with a U.S. national phase submission (e.g., a Form PTO-1390 or similar transmittal letter indicating a submission under 35 U.S.C. 371, or a declaration executing the international application), the "Request for the Acceptance of Non-English Application Under 37 CFR 1.52(d)" does evidence an intent to enter the U.S. national phase under 35 U.S.C. 371.² Accordingly, the initial Office indication that the present application is a U.S. national phase application under 35 U.S.C. 371 of PCT/FR98/00270 is appropriate.

Pursuant to former 37 CFR 1.494, which is applicable to international application PCT/FR98/00270, the international application became abandoned as to the United States for failure to timely pay the full U.S. basic national fee required under 35 U.S.C. 371(c)(1) prior to the expiration of 20 months from the priority date. The Notice mailed to applicants on 31 August 1998 was in error.

Pursuant to 37 CFR 1.137(b), a petition to revive the present application based upon unintentional abandonment must include: (1) the proper reply, unless previously filed; (2) the petition fee under 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional; and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

With respect to item (1), the U.S. basic national fee has been paid.

¹ See, e.g., Office Action dated 30 September 1999 restricting inventions based on lack of unity under PCT Rule 13, and Request for Corrected Filing Receipt dated 18 November 2002.

² The Request states: "To secure the effective PCT and French priority dates, it is necessary that this application be filed on August 5, 1998, to enter the United States national phase." (Emphasis added). The submission under 37 CFR 1.52(d) was unnecessary, as the requirement for an English translation of an international application entering the U.S. national phase is governed by 35 U.S.C. 371 and 37 CFR 1.494 or 1.495.

With respect to item (2), the petition fee has been paid.

With respect to item (3), the petition includes the required statement of unintentional delay.

With respect to item (4), a terminal disclaimer and fee are not required.

II. Request for Status Under 37 CFR 1.42

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. See 37 CFR 1.42. Such oath or declaration must satisfy the requirements of 37 CFR 1.497(b)(2), which provides:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

The original declaration filed 01 February 1999 identifies a deceased inventor (Guy Champigny) but fails to comply with 37 CFR 1.497(b)(2), as it fails to state the relationship of the persons to the inventor and fails to include the residence, citizenship and mailing addresses of such persons. In addition, while three such persons are indicated, only one signature appears. Furthermore, the declaration contains non-initialed/non-dated alterations (e.g., name of third inventor "Lingueglia" has been altered). For these reasons, the declaration filed 01 February 1999 cannot be accepted.

Applicants filed new declarations on 07 July 2010. However, these declarations also fail to comply with the provisions of 37 CFR 1.497(b)(2), as the mailing address and citizenship of the legal representatives have not been provided. In addition, the declaration fails to include the citizenship of the deceased inventor, as required under 37 CFR 1.497(a). Finally, the submission does not include complete copies of each declaration executed by the inventors and legal representatives. For these reasons, the declarations filed 07 July 2010 cannot be accepted.

CONCLUSION

For the above reasons, the petition under 37 CFR 1.137(b) to revive international application PCT/FR98/00270 as to the United States is **GRANTED**.

The request for status under 37 CFR 1.42 is **DISMISSED**.

Applicants have **TWO (2) MONTHS** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497. Failure to timely file the proper reply will result in **ABANDONMENT** of the application. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-3288
Facsimile: (571) 273-0459